

#### REMARKS/ARGUMENTS

Claims 1-3, 5, 6, 10-20 and 22-32 are currently pending in the present application. Reconsideration is respectfully requested in light of the arguments and amendments set forth herein. The allowability of claims 5, 6, 10, 11 and 22-31 is gratefully acknowledged.

#### REJECTIONS UNDER 35 U.S.C. §102:

Claim 12 was rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent Application Publication No. 2002/0130480 to VanDenberg. Claim 12 defines a suspension system for suspending a vehicle frame above a plurality of ground-engaging wheels that comprises, among other things, a pair of trailing arms each comprising a first end and a second end, wherein the second end of each trailing arm comprises a lip extending radially outward from an aperture and at least one engagement surface extending radially outward from the lip and adapted to abut a bushing-removal tool. VanDenberg does not disclose a lip extending radially outward from an aperture and at least one engagement surface extending radially outward from the lip and therefore cannot anticipate the present claim. Specifically, VanDenberg discloses a perimeter 45 that includes perimeter walls 47 and 49. See, VanDenberg ¶36. Moreover, it is noted that VanDenberg fails to disclose using the perimeter of the bushing aperture as disclosed therein as an abutment surface for a bushing removal and Applicants fail to see how the same would be accomplished.

Claim 12 was further rejected on the grounds that “the recitation that an element is” adapted to “perform a function is not a positive limitation..., and does not constitute a limitation in any patentable sense,” citing *In re Hutchinson* 169 USPQ 138. However, MPEP 2173.05(g) clearly states that “a functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used.” See, *Innoval Pure Water Inc. v. Safari Water Filtration Sys., Inc.*, 381 F.3d 1111, 1117-20, 72 USPQ2d 1001, 1006-08 (Fed. Cir. 2004). Therefore, the language of

claim 12 defining the at least one engagement surface as adapted to abut a bushing-removal tool should be given patentable weight.

Moreover, Applicants respectfully contend that the Examiner has not met the burden of establishing a prima facie case of anticipation based upon the prior art. See, *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984). Specifically, claim 12 is rejected in part on the argument that it is “well known that several types of bushing/bearing removal tools simply seat on the surface of the lip, perimeter, or edge of a bushing/bearing housing so as to use the surface as a force application point to pull or push the bushing/bearing from the aperture.” Applicants request that the Examiner articulate such knowledge, and specifically the knowledge of a tool that engages at least one engagement surface extending radially outward from a lip extending about a bushing aperture of a trailing arm, and place it on the record.

In light of the arguments above, Applicants believe claim 12 is in condition for allowance. Claims 13-15 depend from claim 12 which is in condition for allowance, as noted above, and are therefore also in condition for allowance.

REJECTIONS UNDER 35 U.S.C. §103:

Claims 1-3 were rejected under 35 U.S.C. §103 as being unpatentable over VanDenberg in view of Hetmann, U.S. Patent No. 3,904,300. Claim 1 defines a suspension system for suspending a vehicle frame above a plurality of ground-engaging wheels that comprises a wheel-carrying axle comprising a first end and a second end, and a pair of frame bracket assemblies each comprising a resiliently-bushed pivotable connection defining a pivot axis, wherein the frame bracket assemblies operably couple to opposite sides of the vehicle frame, and wherein the resiliently-bushed pivotable connection comprises a substantially cylindrically-shaped bushing. Claim 1 further defines the suspension system as comprising a pair of trailing arms each comprising a first end operably coupled to the first end and the second end of the axle, respectively, and a second end comprising an aperture that receives the bushing of one of the frame bracket assemblies therein, wherein the aperture of the

second end of the trailing arm is oval-shaped, thereby causing a non-symmetrical compression of the bushing about the pivot axis.

It is well established law that “the scope of pertinent prior art has been defined as that reasonably pertinent to the particular problem with which the inventor was involved.” *Lindemann Maschine Fabrik GmbH. v. American Hoist and Derrick Co.*, 730 F.2d 1452, 1460, 221 U.S.P.Q. 481, 487 (Fed. Cir. 1984). (quoting *Stratoflex, Inc. v. Arrowquip Corp.*, 713 F.2d 1530, 1535, 218 U.S.P.Q. 871, 876 (Fed. Cir. 1983)). Further, the proper test for evaluating prior art under 35 U.S.C. §103 is whether or not the prior art, either individually or taken together, can be seen as suggesting the Applicant’s solution to the problem which the invention addresses. *Rosemont, Inc. v. Beckman Instrument, Inc.*, 732 Fed.2d. 1540, 1546, 221, U.S.P.Q. 1, 7 (Fed. Cir. 1984). Moreover, to imbue one of ordinary skill in the art with the knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of hindsight syndrome where that which only the invention taught is used against its teacher. *In re Fine*, 837 Fed.2d 1071, 1075, 5 U.S.P.Q.2d 1596, 1600 (citing *W.L. Gore and Assocs., Inc. v. Garlock, Inc.*, 721 Fed.2d 1540, 1553, 220 U.S.P.Q. 303, 312-313 (Fed. Circuit 1983)).

Applicants again submit that Hetmann is non-analogous art. Specifically, Hetmann discloses an elastic joint and method of assembly for interconnecting steering linkages, especially of motor vehicles. Steering linkages are not analogous to suspension systems as is the subject matter of the present application and claims at issue. Further, the Examiner appears to argue not that the art cited is analogous, but rather that the functionality of that which is disclosed is similar, thereby failing to address the fact that the art as cited is non-analogous. Moreover, Hetmann lacks suggestion or motivation to solve the current problem. Specifically, the current claim defines a suspension system that includes oval-shaped bushing receiving apertures thereby causing nonsymmetrical compression of the bushings about the associated pivot axis and alternating the lateral movement of the entire suspension system while

leaving the amount of roll available unchanged, versus Hetmann that discloses providing a transmission of steering forces in an entirely rigid manner. See Hetmann, column 4, lines 3-23. Still further, Applicants submit that the motivation for combining Hetmann with VanDenberg is based on a hindsight reconstruction using the Applicant's definition of the problem and the claimed solution as a roadmap for such combination. Finally, it is well established that virtually all inventions are necessarily combinations of old elements. The notion, therefore, that combination claims can be declared invalid merely upon finding similar elements in separate prior patents would necessarily destroy virtually all patents and cannot be the law under the statute, §103. See, *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1575, 1 USPQ2d 1593, 1603 (Fed. Cir. 1987). However, the Examiner appears to pick-and-choose desired elements from the art as cited by stating "Hetman is relied on only for an alternative structure for nonsymmetrically compressing a cylindrical bushing." Therefore, neither VanDenberg nor Hetmann either singularly or held in combination, teach, motivate, or suggest that which is defined in independent claim 1.

Accordingly, claim 1 is in condition for allowance. Claims 2 and 3 depend from claim 1 which is in condition for allowance, as noted above, and are therefore also in condition for allowance.

Claim 13 was rejected under 35 U.S.C. §103(a) as being unpatentable over VanDenberg '480. Claim 13 is dependent from claim 12 as discussed above, therefore, this rejection appears to be moot.

Claims 16-18 and 20 were rejected under 35 U.S.C. §103(a) as being unpatentable over Dilling et al., U.S. Patent No. 5,366,237. Claim 16 defines a suspension system that comprises, among other things, a pair of trailing arms each comprising an outwardly-extending shock support tang operably coupled to a shock absorber, wherein each of the trailing arms comprises a single-cast piece. Although Dilling et al. does disclose an outwardly-extending shock-absorbing tang, Dilling et al. discloses the tang as being welded to the associated structure, not comprising a single-cast piece as defined in the claim. The cast-forming as defined results in a

significant reduction of cost by eliminating separate manufacturing steps. MPEP 2173.05(p) states that a product-by-process claim, which is a product claim that defines the claimed product in terms of the process by which it is made, is proper. See *In re Luck*, 476 F.2d 65, 177 USPQ 523 (CCPA 1973).

Claim 18 defines a suspension system that comprises, among other things, a pair of trailing arms, each including a second end having a top surface comprising a first portion and a second portion, wherein the second portion is adapted to support an air spring thereon, and wherein the second portion extends above the first portion, thereby substantially reducing an amount of contact between the trailing arm and a boot of the air spring when the air spring is in a deflated condition. Claim 18 was rejected on the grounds that Dilling et al. discloses a top surface comprising a first portion and a second portion, wherein the second portion is adapted to support one of a pair of air springs therein, wherein the second portion extends above the first portion. However, Dilling et al. does not disclose an elevated portion that would substantially reduce an amount of contact between a trailing arm and a boot of an air spring when the air spring is in the deflated condition and therefore does not render obvious that which is defined in claim 18. It is noted that the two-surface configuration of the Dilling et al. reference does not provide any additional clearance from the bladder of an air spring when the air spring is deflated. Further, the Examiner again fails to give patentable consideration to what the Examiner calls functional language. Applicants respectfully request the Examiner review the claim in light of MPEP 2173.05(g), and further that the invention as defined in claim 18 be considered as a whole (MPEP 2141.02(i)).

Claims 14 and 15 were rejected under 35 U.S.C. §103(a) as being unpatentable over VanDenberg in view of Richardson, U.S. Patent No. 5,836,698, while claim 19 was rejected under 35 U.S.C. §103(a) as being unpatentable over Dilling et al., U.S. Patent No. 5,366,237 in view of Dudding et al. Applicants believe these rejections to be moot in view of the amendments and remarks noted above.

Accordingly, claims 1-3, 5, 6, 10-20, and 32 are believed to be condition for allowance, and a Notice of Allowability is earnestly solicited.

Respectfully submitted,

By: Price, Heneveld, Cooper,  
DeWitt & Litton, LLP

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/Brian E. Ainsworth/

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Brian E. Ainsworth  
Registration No. 45 808  
695 Kenmoor, S.E.  
Post Office Box 2567  
Grand Rapids, Michigan 49501  
(616) 949-9610

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